

REMARKS

This responds to the Office Action mailed on June 13, 2006, and the references cited therewith.

Claims 1-2, 6, 11-12, 19, 21, 25 and 28 are amended and claims 29 and 30 are added; as a result, claims 1-30 are now pending in this application.

Support for new claims 29 and 30 can be found in at least paragraphs 23 and 61 and FIG. 4 of the filed application. Applicants submit that no new subject matter has been added.

Claim Objections

Claims 1 and 11 were objected to as being for informalities. Applicants have amended claims 1 and 11 in accordance with the Examiner's suggested revisions.

Information Disclosure Statement

Applicants submitted an Information Disclosure Statement and a 1449 Form on March 23, 2004. Enclosed are copies of the references cited in the Information Disclosure Statement and a copy of the 1449 Form. Applicants respectfully request that initialed copies of the 1449 Forms be returned to Applicants' Representatives to indicate that the cited references have been considered by the Examiner.

§112 Rejection of the Claims

Claims 12 and 19 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Applicants have amended claims 12 and 19 to more clearly describe Applicants' invention.

§102 Rejection of the Claims

Claims 1-2, 4-11, 21 and 23-28 were rejected under 35 U.S.C. § 102(b) for anticipation by Hirooka et al. ("Extending content-based recommendation by order-matching and cross-matching methods"). Applicants respectfully traverse these rejections.

Claims 1, 21, 25, and 28:

Applicant cannot find in the cited portions of Hirooka “identifying a term associated with a user interaction in the network-based commerce system, the identified term occurring within a search query,” as currently recited in claim 1, and similarly recited in claims 21, 25, and 28. Instead, Hirooka apparently discloses using one of three sources to derive a recommendation listing: book information, customer profile information, and customer purchases. *See* Hirooka at § 4.1. Customer profiles are apparently constructed using past purchase history as described generally in section 3.3 and specifically in sections 3.3.1 and 3.3.2. However, Hirooka does not disclose or describe identifying a term occurring within a search query, generating a recommendation query that includes the search term, and presenting a recommended listing (identified using the recommendation query) to a user, as is required by claim 1 of the present application. The above argument is also applicable to a consideration of independent claims 21, 25, and 28. Thus, because Hirooka does not disclose or describe all elements of claims 1, 21, 25, and 28, Applicants respectfully submit that there is no *prima facie* case of anticipation and respectfully request withdrawal of the basis of these rejections of these claims.

Claims 2, 4-11, 23, 24, 26, and 27:

Applicants respectfully submit that claims 2, 4-11, 23, 24, 26, and 27 depend directly or indirectly on independent claims 1, 21, and 25, respectively. As such, these dependent claims incorporate all the limitations of their parent independent claims. Accordingly, Applicants submit that these dependent claims are patentable for at least the reasons set forth above.

For example, Applicants cannot find in the cited portions of Hirooka “the identified term is selected based on its existence in a predetermined minimum number of user-generated search queries submitted to the network-based commerce system” as currently recited in claim 6. As discussed above with reference to claim 1, Hirooka apparently does not obtain terms from prior user queries when constructing the vector of keywords for the customer’s profile. As such, Hirooka would plainly fail to disclose only using keywords that exist a threshold minimum number of times in such user queries.

As a further example, Applicants cannot find in the cited portions of Hirooka “retrieving at least one popular search term associated with the category data; and generating the

recommended listing based on the popular search term” as recited in claim 10. The Office Action apparently attempts to construe an equivalence of Hirooka’s keyword weighting system and Applicants’ popular search term limitation. Applicants respectfully disagree with such a characterization of Hirooka. As described in Hirooka, given a keyword, the frequency of the keyword in a book may proportionately increase the recommendation rating of the book, such that a book that contains more instances of the keyword are ranked higher when compared to other books that contain fewer instances of the keyword. This weighting is not equivalent to determining frequently used search terms. The most obvious difference being that Hirooka’s keyword is derived from a previous purchase—not a search—and thus, could not be a “popular search term” as required by claim 10.

Thus, Applicants respectfully request withdrawal of any basis of rejection of claims 2, 4-11, 23, 24, 26, and 27. For brevity, Applicants reserve the right to present further remarks concerning the patentable distinctiveness of such dependent claims.

§103 Rejection of the Claims

Claims 3, 12-20 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirooka in view of Ryan (U.S. Publication No. 2003/0055831). Applicants respectfully traverse these rejections.

Claims 3, 12-20, and 22:

Applicants respectfully submit that claims 3, 12-20, and 22 depend directly or indirectly on independent claims 1 and 21, respectively. As such, these dependent claims incorporate all the limitations of their parent independent claims. Accordingly, Applicants submit that these dependent claims are patentable for at least the reasons set forth above. Thus, Applicants respectfully request withdrawal of any basis of rejection of claims 3, 12-20, and 22. For brevity, Applicants reserve the right to present further remarks concerning the patentable distinctiveness of such dependent claims.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 13 day of October 2006.

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